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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,328	09/22/2005	Koji Okomori	159-87	3539
23117	7590	04/07/2006		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER SHEWAREGED, BETELHEM	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/527,328	OKOMORI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Betelhem Shewareged	1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/10/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/402,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claimed coated paper and the coated paper of '108 contain a base paper and a coating layer containing a pigment, an adhesive, and a hollow pigment, wherein the base paper contains inorganic particles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. (JP 2002-088679) in view of Matsumura et al. (JP 2002-161494) and Ryu et al. (US 2001-288690).

Kai discloses a coated paper for gravure printing comprising a coated layer having an adhesive and a pigment on a base paper, wherein kaolin having a particle size in a range of 0.4-4.2  $\mu$ m is contained in an amount of 65% or more based on the volume, is contained as the pigment in an amount of 50 parts by weight or more per 100 parts by weight of the pigment (abstract). Kai does not disclose hollow pigment in the coating layer.

Matsumura teaches a gravure printing paper containing a paper and a coating layer containing hollow organic pigment provided on the paper (abstract).

Kai and Matsumura are analogous art because they are from the same field of endeavor that is the gravure coated paper art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a hollow organic pigment so as to improve the glossiness property of the layer.

With respect to claim 3, at the time of the invention, it is notoriously known to add amorphous silicate in the paper so as to control flexibility while retaining mechanical strength (see Ryu et al.).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. (JP 2002-088679) in view of Sasaki et al. (JP 11-279990) and Ryu et al. (US 2001-288690).

Kai discloses a coated paper for gravure printing comprising a coated layer having an adhesive and a pigment on a base paper, wherein kaolin having a particle size in a range of 0.4-4.2  $\mu$ m is contained in an amount of 65% or more based on the volume, is contained as the pigment in an amount of 50 parts by weight or more per 100 parts by weight of the pigment (abstract). Kai does not disclose hollow pigment in the coating layer.

Sasaki teaches a gravure printing paper containing a paper and a coating layer containing hollow organic pigment provided on the paper (abstract).

Kai and Sasaki are analogous art because they are from the same field of endeavor that is the gravure coated paper art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a hollow organic pigment so as to enhance the ink receiving property of the layer.

With respect to claim 3, at the time of the invention, it is notoriously known to add amorphous silicate in the paper so as to control flexibility while retaining mechanical strength (see Ryu et al.).

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. (JP 2002-088679) in view of Hirose et al. (JP 03-082897) and Ryu et al. (US 2001-288690).

Kai discloses a coated paper for gravure printing comprising a coated layer having an adhesive and a pigment on a base paper, wherein kaolin having a particle size in a range of 0.4-4.2  $\mu\text{m}$  is contained in an amount of 65% or more based on the volume, is contained as the pigment in an amount of 50 parts by weight or more per 100 parts by weight of the pigment (abstract). Kai does not disclose hollow pigment in the coating layer.

Hirose teaches a gravure printing paper containing a paper and a coating layer containing hollow organic pigment provided on the paper (abstract).

Kai and Hirose are analogous art because they are from the same field of endeavor that is the gravure coated paper art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a hollow organic pigment so as to improve the printing property of the layer.

With respect to claim 3, at the time of the invention, it is notoriously known to add amorphous silicate in the paper so as to control flexibility while retaining mechanical strength (see Ryu et al.).

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7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. (JP 2002-088679) in view of Hayashi et al. (JP 06-235194) and Ryu et al. (US 2001-288690).

Kai discloses a coated paper for gravure printing comprising a coated layer having an adhesive and a pigment on a base paper, wherein kaolin having a particle size in a range of 0.4-4.2  $\mu$ m is contained in an amount of 65% or more based on the volume, is contained as the pigment in an amount of 50 parts by weight or more per 100 parts by weight of the pigment (abstract). Kai does not disclose hollow pigment in the coating layer.

Hayashi teaches a gravure printing paper containing a paper and a coating layer containing hollow organic pigment provided on the paper (abstract).

Kai and Hayashi are analogous art because they are from the same field of endeavor that is the gravure coated paper art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a hollow organic pigment so as to enhance the printing property and glossiness of the layer.

With respect to claim 3, at the time of the invention, it is notoriously known to add amorphous silicate in the paper so as to control flexibility while retaining mechanical strength (see Ryu et al.).

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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.  
March 31, 2006.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER